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EXAMINER

PIKE, A

ART UNIT	PAPER NUMBER
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3651

DATE MAILED: 10/09/98

Please find below and/or attached an Office communication concerning this application or  
proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/083,422**

Applicant(s)  
**Clare et al.**

Examiner  
**Andrew C. Pike**

Group Art Unit  
**3651**



☒ Responsive to communication(s) filed on Sep 21, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-5, 7, 10-12, 14, 24-28, and 30-42 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-5, 7, 10-12, 14, 24-28, and 30-42 is/are rejected.

☒ Claim(s) 7 and 35-42 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on May 22, 1998 is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Sep 21, 1998 is ☐ approved ☒ disapproved.

☒ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### ***Priority***

1. Applicants have claimed priority for receiving the benefit under 35 U.S.C. § 120 of the earlier filing dates of U.S. patent applications Serial No. 08/910,516 filed August 2, 1997, as a continuation thereof, No. 08/685,678 filed July 24, 1996, of which No. 08/910,516 is a continuation-in-part, and No. 08/506,893 filed July 26, 1995, of which No. 08/685,678 a continuation-in-part, by including specific references thereto in the present application as the first sentence of the specification thereof. However, Applicants have not submitted an oath or declaration which is in compliance with 37 C.F.R. § 1.63(d) with respect to Serial No. 08/506,893. Further, Applicants state on page 5 in the response filed September 21, 1998, that the present application is intended to only be a continuation, specifically only a continuation of No. 08/910,516.

Applicants are required to either perfect the claim for priority under 35 U.S.C. § 120 by fully complying with 37 C.F.R. § 1.63(d) as stated in paragraph 2 hereinafter, or disclaim the priority under 35 U.S.C. § 120 to applications Serial Nos. 08/685,678 and 08/506,893 by filing a statement disclaiming the benefit under 35 U.S.C. § 120 of the earlier filing dates of Nos. 08/685,678 and 08/506,893, by filing an amendment canceling the specific references to Nos. 08/685,678 and 08/506,893 in the first sentence of the specification of the present application, and by submitting a supplemental oath or declaration which does not include a claim for priority to Nos. 08/685,678 and 08/506,893 under 35 U.S.C. § 120.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying this application by application number and filing date is required. See M.P.E.P. §§ 602.01 and 602.02.

The oath or declaration is defective because:

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It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. § 120, which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 C.F.R. § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

Specifically, it fails to also so acknowledge the claim of priority under 35 U.S.C. § 120 of the continuation-in-part status with respect to application Serial No. 08/506,893.

***Claim Rejections - 35 U.S.C. § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-5, 7, 10-12, 14, 24, 31-33, and 35-42 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The word "one", singular, is inconsistent with the word "components", plural, in the phrase "one components" in claim 24, line 2.

The following lack clear antecedent basis: claim 1: line 8, "a side panel" (deletion of the word "a" in claim 1,

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line 8, and insertion therefor of "said one" is suggested);  
line 12, "said side panel" (which: the "one ... side panel[]" of  
claim 1, line 6-7, the "side panel" of claim 1, line 8, another  
of the "side panels" of claim 1, line 2, or a different, third  
"side panel"?); claim 4: lines 3-4, "said side panel"; claim 10:  
line 3, "said side panel"; claim 12: line 2, "said side panel";  
claim 31: line 3, "said wheel well"; line 4, "said wheel well";  
claim 32: line 2, "said wheel well"; claim 33: line 2, "said  
wheel well"; claim 35: line 12, "a side panel"; lines 14-15, "a  
side panel"; line 16, "said side panel"; line 20, "said overall  
side panel" (the terminology "overall side panel" has not been  
previously so recited); line 22, "said side panel"; claim 38:  
line 3, "a side panel"; line 4, "side panels"; line 6, "said side  
panel"; line 8, "said side panels"; claim 40: line 2, "the side  
panel"; line 3, "said side panel"; line 5, "said side panel";  
claim 41: line 3, "said side panel"; claim 42: lines 1-2, "said  
side panel".

### ***Claim Objections***

5. Claims 7 and 35-42 objected to because of the following informalities:

The word "of" in claim 35, line 5, should be deleted. The word "tailgate" is misspelled as "tail gate" in claim 35,

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lines 6-7. The word "further" should follow "bed" in claim 36, line 1.

The following are initial recitations which are not so recited, or are subsequent recitations which are not uniquely and/or consistently recited: claim 7: line 2, "one storage box" (it should be "one said storage box"); line 2, "an interior"; line 3, "hinged side panel section"; line 3, "latch mechanism"; claim 38: line 2, "a storage box" (it should be "one said storage box"); line 2, "an opening".

Appropriate correction is required.

***Claim Rejections - Double Patenting***

6. Claim 11 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of copending Application No. 08/910,516. Although the conflicting claims are not exactly identical, they are not patentably distinct from each other because of the mere variation of non-patentably distinct features in the claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. § 3.73(b).

### ***Claim Rejections - 35 U.S.C. § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office action.

9. Claims 1, 4, 5, 7, and 24 as understood, and 25-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stiles in view of Smith.

Stiles clearly discloses almost all of the claimed features of the hidden storage system for a vehicle having side panels which does not substantially alter an external appearance of the vehicle (see Fig. 1), including *inter alia* a storage box including a compartment mounted on each side of the vehicle

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(page 2, column 2, lines 8-15), each box partially covering a wheel well, one section 22 of one of the side panels on each side of the vehicle being hinged (page 2, column 2, line 9) to be opened and closed to expose and cover an interior of each box, and naturally a latch mechanism to releasably secure each hinged section hidden behind the hinged section thereof; but lacks lock means for actuating the latch mechanism on each side.

Smith clearly discloses (column 1, lines 11-30), as conventional in the art, a hidden storage system for a vehicle having rear panels which does not substantially alter an external appearance of the vehicle, including a storage box including a compartment mounted in the rear side of the vehicle covering wheel wells, one section of one of the rear panels being hinged to be opened and closed to expose and cover an interior of the box, a latch mechanism to releasably secure the hinged section hidden behind the hinged section, and lock means for actuating the latch mechanism hidden behind an escutcheon and decorative cover.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the vehicle of Stiles to include lock means, as taught by Smith, because lock means for actuating latch mechanism, wherein the latch mechanism and the lock means are hidden from view with the external



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appearance of the vehicle being not substantially altered, is conventional in the art (Smith, column 1, lines 13-15).

10. Claims 2, 3, and 31, as understood, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stiles in view of Smith as applied to claims 1 and 25 above, and further in view of Sisler.

Stiles further lacks that each storage box extends over the wheel well thereof along a section of the vehicle floor.

Sisler discloses a hidden storage system, for a vehicle having side panels and a floor, wherein the hidden storage system does not substantially alter the external appearance of the vehicle and comprises a storage box mounted on each side of the enclosure of the vehicle (column 3, lines 36-37) extending along a section of the vehicle floor and having at least one compartment, each box covering over a wheel well forwardly and rearwardly and having a height less than that of the side panels and being hidden with the external vehicle appearance not being substantially altered.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the vehicle of Stiles, as modified by Smith, to have each storage box extend over the wheel well thereof along a section of the vehicle floor, as taught by Sisler, to use effectively the spaces over

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the wheel wells (Sisler, column 1, lines 15-17 and 22-24, and Figs. 1 and 2).

11. Claims 10 and 12 as understood, and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stiles in view of Smith as applied to claims 1 and 25 above, and further in view of Ogilvie, 1966.

Stiles further lacks a strut assembly and a plurality of hinged sections for each box.

Ogilvie, 1966, discloses a storage system, for a vehicle having side panels, wherein the storage system comprises a storage box mounted on each side of the vehicle covering a wheel well forwardly and rearwardly, and, for each box, sections, including at least one entirely above the wheel well thereof, of a side panel of the vehicle enclosure being hinged for outward movement to open positions, and a strut assembly 110.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the vehicle of Stiles, as modified by Smith, to include a strut assembly and a plurality of hinged sections for each box, as taught by Ogilvie, 1966, because the hinged side panel sections and strut assembly would provide side access to the interior of the storage boxes (Ogilvie, 1966, Fig. 3).

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12. Claims 14 as understood, and 30 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stiles in view of Smith as applied to claims 1 and 25 above, and further in view of LeVee.

Stiles further lacks a drain/air relief valve assembly in a bottom area of each box, and a plurality of horizontally hinged sections for each box.

LeVee discloses a storage system, for a vehicle having side panels, wherein the storage system comprises a storage box mounted on each side of the enclosure of the vehicle covering a wheel well forwardly and rearwardly, and, for each box, sections, including at least one entirely above the wheel well thereof, of a side panel of the vehicle enclosure being horizontally hinged for outward movement to open positions, and drain/air relief valve assemblies 60 in a bottom area of the boxes.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the vehicle of Stiles, as modified by Smith, to include a drain/air relief valve assembly in a bottom area of each box, and a plurality of horizontally hinged sections for each box, as taught by LeVee, because the hinged side panel sections would provide side access to the interior of the storage box (LeVee, Fig. 2) and the drain/air relief valve assemblies would prevent moisture condensation (LeVee, column 4, lines 15-17).

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13. Claims 31-33, as understood, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stiles in view of Smith as applied to claim 25 above, and further in view of LeVee and Sisler.

Stiles further lacks that the hinged section is located entirely above the wheel well, extending forwardly, rearwardly, and over.

Paragraph 12 above is incorporated by reference as to LeVee.

Paragraph 10 above is incorporated by reference as to Sisler.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the vehicle of Stiles, as modified by Smith, to have the hinged section located entirely above the wheel well, extending forwardly, rearwardly, and over, as taught and suggested by LeVee and Sisler, to provide side access to the interior of the storage boxes (LeVee, Fig. 2) and to use effectively the spaces over the wheel wells (Sisler, column 1, lines 15-17 and 22-24, and Figs. 1 and 2).

14. Claims 1-5, 7, 10, 12, and 24 as understood, 25-28, 30, and 31-33 and 35-42 as understood are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sisler in view of Stiles and Ogilvie, 1966.

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Sisler discloses a hidden storage system, for a vehicle including *inter alia* side panels, a driver's side door, a cab, at least one rear door, and an enclosure for equipment having floor, bulkhead, side panel, and tailgate sections, wherein the hidden storage system does not substantially alter the external appearance of the vehicle and comprises *inter alia* a storage box mounted on each side of the enclosure of the vehicle (column 3, lines 36-37) intermediate the doors and extending along a section of the vehicle floor and having at least one compartment, each box covering a wheel well forwardly and rearwardly and having a height less than that of the side panels and being hidden with the external vehicle appearance not being substantially altered; but lacks, for each box, sections of one of the enclosure side panels being hinged for outward movement to open positions, a hidden latch mechanism, lock means, and a strut assembly.

Stiles discloses a hidden storage system, for a vehicle, comprising a storage compartment mounted on each side of the vehicle (page 2, column 2, lines 8-15), each compartment partially covering a wheel well and wherein a portion 22 of a side panel of the vehicle is hinged (page 2, column 2, line 9) to provide access thereto, with the compartment being hidden with the external appearance of the vehicle not being substantially altered.

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Ogilvie, 1966, clearly discloses a storage system, for a vehicle having side panels, a driver's side door, a cab, at least one rear door, and an enclosure for equipment having floor, bulkhead, side panel, and tailgate sections, wherein the storage system comprises a storage box mounted on each side of the enclosure of the vehicle intermediate the doors and extending along a floor thereof and covering a wheel well forwardly and rearwardly, and, for each box, sections, including at least one entirely above the wheel well thereof, of a side panel of the vehicle enclosure being hinged for outward movement to open positions, and having a hidden latch mechanism, including hidden latch members hidden behind the hinged sections, mechanically activated lock means, shelves and compartments, and a strut assembly 110.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sisler to have, for each box, sections of one of the enclosure side panels being hinged for outward movement to open positions, a hidden latch mechanism, lock means, and a strut assembly, as suggested and taught by Stiles and Ogilvie, 1966, because the hinged side panel sections and strut assembly would provide side access to the interior of the storage box (Ogilvie, 1966, Fig. 3; Stiles, page 2, column 2, lines 8-15) without substantially

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altered the external appearance (Sisler, column 1, lines 43-45; Stiles, Fig. 1).

15. Claims 1-3, 5, 7, 12, 14, and 24 as understood, 25-28, 30, 31-33 as understood, 34, and 35-39 and 42 as understood are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sisler in view of Stiles and LeVee.

Sisler discloses a hidden storage system (see paragraph 14 above), but lacks, for each box, sections of one of the enclosure side panels being horizontally hinged for outward movement to open positions, a latch mechanism, lock means, and a drain/air relief valve assembly.

Paragraph 14 above is incorporated by reference as to Stiles.

LeVee clearly discloses a storage system, for a vehicle having side panels, a driver's side door, a cab, at least one rear door, and an enclosure for equipment having floor, bulkhead, side panel, and tailgate sections, wherein the storage system comprises a storage box mounted on each side of the enclosure of the vehicle intermediate the doors and extending along a floor thereof and covering a wheel well forwardly and rearwardly, and, for each box, sections, including at least one entirely above the wheel well thereof, of a side panel of the vehicle enclosure being horizontally hinged for outward movement to open positions, and having a latch mechanism, mechanically activated lock means,

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shelves and compartments, and drain/air relief valve assemblies 60 in a bottom area of the boxes.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sisler to have, for each box, sections of one of the enclosure side panels being horizontally hinged for outward movement to open positions, a latch mechanism, lock means, and drain/air relief valve assembly, as suggested and taught by Stiles and LeVee, because the hinged side panel sections would provide side access to the interior of the storage box (LeVee, Fig. 2; Stiles, page 2, column 2, lines 8-15) without substantially altered the external appearance (Sisler, column 1, lines 43-45; Stiles, Fig. 1), with the drain/air relief valve assemblies preventing moisture condensation (LeVee, column 4, lines 15-17).

### ***Specification***

16. The specification is objected to under 37 C.F.R. § 1.74 as failing to correctly identify the different parts shown in the figures by unique reference numerals required by 37 C.F.R.

§ 1.84(p)(4):

Reference numerals 103 and 104 each improperly identifies more than one feature (e.g., 103 on page 16, lines 4 and 6, should be 103' and 104 on page 16, line 6, should be 104', 103 on page 16, line 27, should be 303 and 104 on page 16, line 27,



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should be 304, etc.). Reference numeral 100' improperly identifies more than one feature. The description of the modification shown in Fig. 12 improperly includes reference numerals of other embodiments. The description of the alternative embodiment shown in Fig. 14 improperly includes reference numerals of a different embodiment. The feature "bed 121" on page 20, lines 17-18, is misidentified. The description of the alternative embodiment shown in Fig. 16 improperly includes reference numerals of a different embodiment.

Appropriate correction is required.

17. The specification is objected to under 37 C.F.R. § 1.74 as failing to correctly identify the views in consecutive Arabic numerals required by 37 C.F.R. § 1.84(u)(1):

The twenty figures shown in the drawings are not identified by the consecutive Arabic numerals 1 through 20.

Appropriate correction is required.

18. The specification is objected to under 37 C.F.R. § 1.84(p)(5) as failing to identify reference numerals:

Arrangement 300 (page 16, line 26) is not shown labeled. Members 130' (page 20, line 25) are not shown labeled.

Appropriate correction is required.

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***Drawings***

19. The proposed drawing correction on September 21, 1998, has been disapproved.

The proposed drawing correction failed to overcome all of the objections to the drawings.

Applicants failed to submit formal drawings as required.

20. The drawings are objected to under 37 C.F.R. § 1.84(h) (3) as failing to correctly show sectional views:

The EPDM or rubber (page 25, line 2) is not shown; the housing 187 is instead shown with a metal cross-sectional hatching. Member 196 lacks cross-sectional hatching in Fig. 19.

Correction is required.

21. The drawings are objected to under 37 C.F.R. § 1.84(p) (4) as failing to uniquely and correctly identify reference numerals:

Reference numerals 103 and 104 each improperly labels more than one feature (e.g., 103 and 104 in Fig. 10 should be 103' and 104', etc.). Reference numeral 100' improperly labels more than one feature. The modification shown in Fig. 12 improperly includes reference numerals of other embodiments. The alternative embodiment shown in Fig. 14 improperly includes reference numerals of a different embodiment. The alternative

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embodiment shown in Fig. 16 improperly includes reference numerals of a different embodiment.

Correction is required.

22. The drawings are objected to under 37 C.F.R. § 1.84(p)(5) as failing to show reference numerals:

Feature 80 (page 14, line 1) is not shown labeled.  
Feature 106' (page 15, line 26) is not shown labeled. Rod 153 (page 22, line 12) is not shown labeled. Member 208 (page 24, line 10) is not shown labeled.

Correction is required.

23. The drawings are objected to under 37 C.F.R. § 1.84(u)(1) as failing to correctly consecutively number the views in Arabic numerals:

The twenty figures have not been identified by the consecutive Arabic numerals 1 through 20.

Correction is required.

24. The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "bulkhead section" (claim 28, line 2) must be shown or the feature canceled from the claim. No new matter should be entered.

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25. New FORMAL DRAWINGS are required in response to this Office Action. Any proposal for amendment by the Applicants of the drawings to cure defects must include either:

- (a) new drawings in compliance with 37 C.F.R. § 1.84, including
  - (1) a sketch in permanent black ink showing the originally filed drawings with changes thereto in red ink in compliance with 37 C.F.R. § 1.121(a)(3)(ii), and
  - (2) new formal drawings correcting the noted defects.

This should be in a separate letter, i.e., drawings with a cover letter with an appropriate heading, e.g., "Formal Drawings", in compliance with 37 C.F.R. §§ 1.4(c) and 1.121(a)(3)(ii).

#### ***Response to Amendment***

26. The following amendments filed September 21, 1998, failed to comply with 37 C.F.R. § 1.121(a)(2)(i), and thus were denied entry:

the amendment to claim 24, line 3 ("at." does not occur in line 3 of claim 24).

27. The following amendments filed September 21, 1998, to the claims fail to comply with 37 C.F.R. § 1.121(a)(2)(ii):

twice amended claim 1 lacks the correct parenthetical phrase "(twice amended)"; and

twice amended claim 12 lacks the correct parenthetical phrase "(twice amended)".

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To expedite prosecution on the application, the noted amendments will be acted upon as if the noted insertions and/or deletions were in fact respectively underlined and bracketed.

***Response to Arguments***

28. Applicants' arguments filed September 21, 1998, have been fully considered but they are not persuasive.

Applicants inconsistently include references in the first sentence of the specification of the present application Serial No. 09/083,422 to prior U.S. patent applications Serial No. 08/910,516 (of which No. 09/083,422 is a continuation), No. 08/685,678 (of which No. 08/910,516 is a continuation-in-part), and No. 08/506,893 (of which No. 08/685,678 is a continuation-in-part), thus invoking a claim of priority thereto for the benefit of the dates of August 2, 1997, July 24, 1996, and July 26, 1995, of filing thereof under 35 U.S.C. § 120, but then argue that the present application Serial No. 09/083,422 only includes a claim of priority under 35 U.S.C. § 120 as a continuation of No. 08/910,516 and therefore invoking a claim of priority for only the benefit of the date of August 2, 1997, of filing thereof under 35 U.S.C. § 120. Applicants have failed to properly claim priority under 35 U.S.C. § 120; see paragraphs 1 and 2 above.

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Claims, e.g., 4, lines 3-4, fail to comply with 35 U.S.C. § 112, second paragraph, in that the phrase therein "said side panel" is indefinite as to which previously recited "side panel": the "one ... side panel[]" of claim 1, line 6-7, the "side panel" of claim 1, line 8, another of the "side panels" of claim 1, line 2, or yet another, different "side panel"; see paragraph 4 above.

The claims fail to properly identify that the "storage box" in, e.g., claim 7, line 2, in fact corresponds to the "storage box" previously recited (as opposed to a total of three different storage boxes: the "at least one storage box" on each vehicle side in addition to the "at least one storage box" on one side).

Claim 11 is provisionally rejected under obviousness-type double patenting over claim 11 of copending Application No. 08/910,516, since claim 11 of the present application fails to patentably distinguish of claim 11 in No. 08/910,516; see paragraph 6 above.

Applicants argue as if the unabridged disclosure is being recited in the claims, as if, e.g., the claim terminology "storage box" was exactly identical with Applicants' Fig. 3, i.e., a box having an interior unitarily defined by walls adjacent the tailgate section, the bulkhead section, the upper side wall section, the lower side wall section, and the wheel

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well section, etc. Limitations from a pending application's specification will not be read into claims which lack explicit recitation of those limitations in support of patentability (see *Sjolund v. Musland*, 847 F.2d 1573, 6 USPQ2d 2020 (Fed. Cir. 1988); *In re Self*, 671 F.2d 1344, 213 USPQ 1 (CCPA 1982)).

Applicants have deliberately chosen to recite in, e.g., claim 1, lines 4-5, "at least one storage box having an interior mounted on at least one side of said vehicle". No further limitations thereto apart from the one hinged section, the one latch mechanism, and the lock means are recited therein.

Unquestionably, Sisler does disclose what is being claimed here: "at least one storage box [21; see also column 3, lines 36-37] having an interior [see Fig. 2] mounted on at least one side [see Fig. 1] of said vehicle [column 2, line 12]". It is irrelevant with respect to the storage box as to what Sisler does or does not further disclose since Applicants have deliberately chosen to not further limit the recitation thereof and thus cannot rely on what is not specifically recited as such in the claims for patentability. The claim terminology as recited, e.g., in independent claims 1, 25, and 35, fails to structurally define over the prior art of record.

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Applicants allege that Sisler, Stiles, Ogilvie, 1966, and LeVee fail to disclose various features, e.g., "tailgate", "rear door", etc.; but this miss the disclosures thereof, e.g., Sisler, column 2, line 23, seventh word, "tailgate", etc. For the "doors", the disclosure, e.g., "pickup-type vehicles" in Sisler, column 1, lines 8, naturally includes a driver's side door; further, any pivoting, rear, panel-like closure reads upon "rear door", and thus all tailgates, trunk lids, hatchbacks, etc. are "rear doors"; and therefore it must follow the storage boxes of Sisler, Stiles, Ogilvie, 1966, and LeVee are between the driver's side door and the rear door thereof.

Applicants have deliberately recited "enclosure" in, e.g., claim 25 as being "for passengers, merchandise, or equipment"; thus the claim terminology "enclosure" is not limited to exactly and only a standard eight-foot bed of a two-door pickup truck but is broadly reasonably readable upon any truck bed, any vehicle cab, any passenger compartment, any combination of a bed and cab collectively considered together, any combination of a passenger compartment and trunk collectively considered together, any van body, etc.

Applicants' arguments as to Stiles having "probably" exposed locking mechanism is mere speculation unsupported by the actual disclosure of Stiles. Applicants acknowledge that Stiles teaches



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hinging panel sections 22. Stiles naturally includes a latching mechanism; otherwise, the hinged panel section 22 would swing back and forth unrestrained as the vehicle is being driven about. Stiles shows in Fig. 1 the vehicle thereof with the panel section 22 in the closed position, and thus clearly discloses that the hinging and the latch mechanism for the hinged panel section 22 are not visible when the panel section 22 is in the closed position. Therefore, the hinging and the latch mechanism for the hinged panel section 22 are hidden, and the external appearance of the vehicle is not substantially altered. In fact, the features of Stiles are clearly readable upon almost all of the limitations of the vehicle as claimed as recited in claims 1, 4, 5, 7, and 24-28; Stiles only lacks the lock assembly, which is conventional as taught by Smith. (Of course, as is true for Applicants' invention as plainly seen in Fig. 3, certain of the features which were hidden when the hinged panel sections were in the closed positions are visible when the hinged panel sections are in the open positions.)

Thus, this is true for the conventional hidden storage system, e.g., a trunk, which Smith discloses. When the hinged panel section of the rear panels, e.g., the trunk lid, is in the closed position, the latch mechanism is hidden therebehind and is not visible, and the lock assembly is also hidden therebehind and hidden behind an escutcheon and decorative cover as is

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conventional and is not visible; and the external appearance of the vehicle is not substantially altered.

Contrary to Applicants' arguments, Ogilvie, 1966, clearly discloses strut assembly 110 (claim 10 places no further limitations thereon, e.g., as does claim 11 in reciting insulating means, heating means, and heating and insulating means, and thus assembly 110 is indeed a strut assembly). LeVee clearly discloses drain/air relief valve assembly 60 in a bottom area of the boxes (claim 14 places no further limitations thereon, e.g., the box being defined by a flat inner wall, a flat outer wall, a flat top wall, a flat front wall, a flat bottom wall with an aperture, and a curved rear wall interconnected with each other, the drain/air relief valve assembly being inserted into the aperture and having a lower annular flat mounting flange, an intermediate upwardly inclined flange unitarily extending from the mounting flange, and an upper annular flat connecting flange unitarily extending from the inclined flange and overlapping the flat bottom wall around the aperture, etc., and thus assembly 60 is indeed a drain/air relief valve assembly in the bottom area).

Applicants argue that the Examiner has picked certain details of the references cited without any suggestion therefor. This is without merit. Proper combination of references under 35

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U.S.C. § 103 requires some teaching, suggestion, or inference in any one of the references, or knowledge generally available to one of ordinary skill in the relevant art, which would have led the ordinary skilled artisan to combine the relevant teachings of references: *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., et al.*, 227 USPQ 657 (CAFC 1985), at 667. Citation and location of the teachings, suggestions, or inferences of the references, or generally available knowledge, are clearly stated in paragraphs 9-15 above. This is not dependent upon what each reference lacks but rather what the combined teachings would suggest to one of ordinary skill in the art: *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). While it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, i.e., teachings, suggestions, and inferences of the references and general knowledge of the prior art, and does not include knowledge gleaned exclusively from Applicants' disclosure, such a reconstruction is proper: *In re McLaughlin, supra*. Thus, the rejections under 35 U.S.C. § 103 as stated in paragraphs 9-15 above are indeed proper.

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Applicants have failed to present claims which structurally distinguish patentably over the prior art of record.

Applicants have not fully complied with 37 C.F.R. § 1.84(p)(4). Regardless of Applicants' arguments, Applicants manifestly agree with the Examiner's position; note Applicants' partial compliance therewith in, e.g., 10 as designating an embodiment shown in Fig. 1, 70 designating an embodiment shown in Fig. 7, 80' designating an embodiment shown in Figs. 8, etc. Otherwise, by Applicants' arguments, all vehicles of the embodiments would be designated 10, all cabs designated 11, all panel sections designated 15, etc., which clearly fails to comply with 37 C.F.R. § 1.84(p)(4).

Sequential numbering of the figures is confirmed to be proper and required; see 37 C.F.R. § 1.84(u)(1):

The different views must be numbered in consecutive Arabic numerals, starting with 1, independent of the numbering of the sheets and, if possible, in the order in which they appear on the drawing sheet(s). Partial views intended to form one complete view, on one or several sheets, must be identified by the same number followed by a capital letter. View numbers must be preceded by the abbreviation "FIG." Where only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation "FIG." must not appear.

Clearly, e.g., Figs. 8A and 8B are not partial views intended to form one complete view; instead, they are different views showing alternative embodiments in accordance with 37 C.F.R. § 1.84(h)(5)

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("Modified forms of construction must be shown in separate views."). Thus, the drawings currently fail to comply with 37 C.F.R. § 1.84(u)(1); see paragraphs 17 and 23 above.

Applicants argue that the claimed bulkhead section is shown in Figs. 2 and 4. However, the specification on page 10, lines 12-15, fails to teach that the bulkhead section is shown, but states that other sections are instead shown.

Applicants have failed to file new formal drawings in response to the Office action mailed August 18, 1998, Paper No. 6. Since the present application is a continuation of allowed application Serial No. 08/910,516, new formal drawings are required in response to this Office action; see paragraph 25 above.

### **Conclusion**

29. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Andrew Pike whose telephone number is (703) 308-3423.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Correspondence related to this application may be transmitted by facsimile in accordance with 37 C.F.R. § 1.6, except for that correspondence for which facsimile transmission is prohibited under 37 C.F.R. § 1.6(d). Facsimile copies of an original signature under 37 C.F.R. § 1.4(d)(2) on correspondence transmitted by facsimile under 37 C.F.R. § 1.6 are acceptable. Applicants should retain the original correspondence papers as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original correspondence

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papers; BUT APPLICANTS SHOULD **NOT** SUBMIT THE ORIGINAL  
CORRESPONDENCE PAPERS IN ADDITION TO THAT TRANSMITTED BY  
FACSIMILE unless specifically required to by the Office. The  
Technology Center 3600 Fax Center facsimile number is (703) 305-  
7687.

*Andrew C. Pike*  
10-6-1998  
ANDREW C. PIKE  
PRIMARY EXAMINER  
ART UNIT 3615

acp  
October 6, 1998